

**UNITED STATES PATENT AND TRADEMARK  
OFFICE**

**REQUEST FOR FILE WRAPPER CONTINUING APPLICATION UNDER 37 CFR 1.62  
(RULE 62)**

**For Design or Utility Applications**

BOX FWC

3515 U.S. PTO



Hon. Commissioner of Patents  
and Trademarks  
Washington, D.C. 20231

Prior Application: 08/583,491

Group Art Unit: 1818

Examiner: M. Allen

Atty Dkt: 241800/

new M#/Client Ref.

(Our Deposit Account No. 03-3975

(Our Order No. 20263/241800

C# / new M#

Date: November 7, 1997

Sir:

This is a **RULE 62 REQUEST** for filing from

prior copending parent Application No. 08/583,491

series code ↑ serial no.

☐ divisional

☒ continuation (**Exr. NOTE:** any election in parent as to species/restriction requirement:

☐ is carried over with traverse ☐ is not carried over)

☐ continuation-in-part **without** new Declaration (Rule 62(d))

☐ without fee

☐ continuation-in-part (with new Declaration attached hereto)

The parent was filed on January 5, 1996

, entitled **GDF-1,**

by the following named inventor(s) who is/are ☒ the same as, ☐ less than all of (see Item 17),

☐ more than (for CIP only), those named in that parent application:

(1) Inventor	Se-Jin		LEE
Residence	Baltimore	Maryland	USA
Post Office Address	2509A Steele Road, Baltimore Maryland 21209		
(include Zip Code)			
(2) Inventor			
Residence			
Post Office Address			
(include Zip Code)			
(3) Inventor			
Residence			
Post Office Address			
(include Zip Code)			
(4) Inventor			
Residence			
Post Office Address			
(include Zip Code)			
(5) Inventor			
Residence			
Post Office Address			
(include Zip Code)			

**NOTE: FOR ADDITIONAL INVENTORS**, check box ☐ and attach sheet (CDC-110A) with same information with same information for each inventor starting with inventor No. 6 and number new page 1A.

1. **Requirement of Rule 62.** Rule 62 filings are to be used only when the issue fee has not been paid (except as noted below) in the above-identified prior application nor that application abandoned or its proceedings terminated. This Rule 62 filing will be considered by the PTO as an express abandonment of that prior application except when this Rule 62 filing is pursuant to Rule 313(b)(5), i.e., when the issue has been paid in the prior application and a petition filed to abandon that application to permit an IDS to be considered in this Rule 62 application. (Note: 37 CFR 1.53 (Rule 53) may be used for continuations and divisions where the prior application is not to be abandoned.)

2. ☐ The issue fee has been paid in the parent, but this Rule 62 Request follows a Rule 313(b)(5) petition, and per 1138 OG 40 waiver is respectively requested of that part of Rule 62 which prohibits use of the rules to file an FWC after payment of the issue fee.

3. ☐ Priority is claimed under 35 U.S.C. 119/365 based on filing in \_\_\_\_\_ of: \_\_\_\_\_ (country)

Application No.	Filing Date	Application No.	Filing Date
(1) _____	_____	(4) _____	_____
(2) _____	_____	(5) _____	_____
(3) _____	_____	(6) _____	_____

a. ☐ (No.) Certified copy/copies attached.

b. ☐ Certified copy/copies previously filed on \_\_\_\_\_ in prior U.S. Application No. \_\_\_\_\_ / \_\_\_\_\_, filed on \_\_\_\_\_

c. ☐ Certified copy/copies filed during International stage of PCT/ \_\_\_\_\_ / \_\_\_\_\_

d. ☐ Priority is also claimed from PCT/ \_\_\_\_\_ / \_\_\_\_\_ filed \_\_\_\_\_

4. ☒ The prior application is assigned of record to Carnegie Institution of Washington by Assignment recorded January 16, 1991 Reel 5582 Frame 0797.

5. ☐ Attached is an assignment Cover Sheet.  
Please return the recorded Assignment to the undersigned.

6. ☒ The power of attorney in the prior application is to Paul N. Kokulis, Reg. No. 16,773

(Name, Reg. No.) ↑

7. ☐ Recognize as associate attorney \_\_\_\_\_

(Name and Reg. No.; Address as in item 8 unless otherwise indicated) ↑

8. **Address all future communications to Cushman Darby & Cushman**, Intellectual Property Group of Pillsbury Madison & Sutro LLP, Ninth Floor, East Tower  
1100 New York Avenue, N.W., Washington, D.C. 20005-3918

9. ☒ Amend the specification by inserting before the first line (in place of any comparable insert previously requested in any prior application) the sentence: This is a

☐ continuation-in-part (CIP) ☒ continuation ☐ division

of application No. 08/583,491, filed on January 5, 1996, which was

series code ↑ serial no.  
abandoned upon the filing hereof which is a continuation of Serial No. 08/316,456, filed October 3, 1994,  
now abandoned, which is a continuation of Serial No. 08/090,002, filed July 12, 1993, now abandoned,  
which is a continuation of Serial No. 07/614,452, filed November 16, 1990, now abandoned.

102 ☒ 1 (No.) Verified Statement(s) establishing "small entity" status under Rules 9 and 27

- a. ☒ filed in above prior application (and hence applicable hereto)  
b. ☐ attached.

11. **Requirement of Rule 62.** It is understood that secrecy under 35 U.S.C. 122 is hereby waived to the extent that if information or access is available to any one of the applications in the file wrapper of a 37 CFR 1.62 application, be it either this application or a prior application in the same file wrapper, the Patent and Trademark Office may provide similar information or access to all the other applications in the same file wrapper.

12. Petition to extend the life of the above prior application to at least the date hereof

NOTE: (One box) ☒ is being concurrently filed in that prior application (Use Form CDC-111).  
 (must be) ☐ was previously filed in that prior application (Check length of prior extension).  
 (X'd) ☐ is not necessary for copendency (Double check before X'ing this box).

13. ☐ Please enter the amendment previously filed on \_\_\_\_\_ but unentered in the above prior application.

14. ☐ Attached: \_\_\_\_\_ sheet(s) per set of drawing of Fig(s) : \_\_\_\_\_  
☐ 1 set informal; ☐ formal of size: ☐ A4 ☐ 11"

15. ☐ **PRELIMINARY AMENDMENT to be entered before fee calculation** (Do not make amendments here except cancellation of whole claims or multiple dependencies for purpose of reducing the filing fee per MPEP §§ 506 and 607; do not cancel all claims.):

16. ☒ Attached is a Rule 103(a) Petition to suspend action

17. Petition is hereby made requesting deletion as inventor(s) of the following who is/are not inventor(s) of the invention being claimed in this Rule 62 application:

1. \_\_\_\_\_ 2. \_\_\_\_\_  
 3. \_\_\_\_\_ 4. \_\_\_\_\_

18. ☐ This Rule 62 application is a continuation-in-part which discloses and claims additional matter and the amendments in attached Amendment are to be considered an integral part of the CIP ab initio.

a. ☐ New Declaration is attached.

b. ☐ This application is also filed under Rule 62(d) (without a Declaration) and hence filing fee is not enclosed.

#### FILING FEE

THE FOLLOWING FILING FEE IS BASED ON THE CLAIMS  
 EXISTING IN THE PRIOR APPLICATION AS AMENDED AT 13 AND 15 ABOVE

				Large/Small Entity		Fee Code
19. Basic Filing Fee . . . . . Design Application				\$330/\$165		106/26
20. . . . . Not Design Application				\$790/\$395	+395	101/201
21. Total Effective Claims	8	minus 20 =	0	x \$22/\$11	+0	103/203
(Base this ⚡ on claims <u>as amended</u> to effect CIP if this is a Rule 62(d) completion)						
22. Independent Claims	1	minus 3 =	0	x \$82/\$41	+0	102/202
23. If <u>any proper</u> multiple dependent claim (ignore improper) is present, (Leave this line <u>blank</u> if this is a <u>reissue</u> application)				\$270/\$135	+0	104/204
TOTAL FILING FEE =					\$395	
24. If "assignment" box 5 is X'd, add recording fee. . . . .				\$40	+	581
26. If "petition" box 16 above is X'd, add petition fee. . . . .				\$130	+130	122
FEE ATTACHED =					\$525	

27.

(carry forward to line 36)

28. ☒ Preliminary Amendment attached (to be entered after assigning Appln. No.).  
(Do NOT X box 28 or 29 for CIP Amendment. See box 18)
29. ☐ The following PRELIMINARY AMENDMENT is to be entered after assigning Appln. No.:

30. ☒ ATTACHED:  
Request for Suspension of Action

**ADDITIONAL FEE CALCULATION FOR  
PRELIMINARY AMENDMENT  
PER BOXES 28/29**

	Claims remaining after amendment	Highest number previously paid for	Present Extra		Additional Fee	File Code
				<u>Large/Small Entity</u>		
32.	Total Effective Claims <u>15</u>	minus ** <u>20</u> = *	<u>0</u>	x \$22/\$11	= \$ <u>0</u>	(103/203)
33.	Independent Claims <u>3</u>	minus *** <u>3</u> = *	<u>0</u>	x \$82/\$41	= + <u>0</u>	(102/202)
34.	If amendment enters proper multiple dependent claim(s) into this application for the <u>first time</u> , add .....\$270/\$135(per application)				+ <u>0</u>	(104/204)
35.				ADDITIONAL FEE	\$ <u>0</u>	
36.				plus FEE from item 27 on page 3	+ <u>525</u>	
37.				<b>TOTAL FEE ATTACHED</b>	\$ <u><u>525</u></u>	

38. \*If the entry in the first space is less than an entry in the middle space, the "Present Extra" result is "0"
39. \*\*If the "Highest number previously paid for" (see item 21 above) is less than 20, write "20" in this space
40. If the "Highest number previously paid for" (see item 22 above) is less than 3, write "3" in this space

**CHARGE STATEMENT:** The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficient fee only) now or hereafter relative to this application and the resulting Official document under Rule 20, or credit any overpayment, to our Account/Order Nos. shown in the heading hereof for which purpose a duplicate copy of this sheet is attached. This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal form is filed.

1100 New York Avenue, N.W.  
Ninth Floor East Tower  
Washington, D.C. 20005-3918  
Tel: (202) 861-3000  
PNK/GRT/hc

**Cushman Darby & Cushman  
Intellectual Property Group of  
Pillsbury/Madison & Sutro LLP**

By: Attorney Paul N. Kokulis

Sig: Paul C. Kunkel

Reg. No. 16,773

Fax: (202) 822-0944  
Tel: (202) 861-3503

**NOTE: No: 1:** File this Request in duplicate with 2 postcard receipts (CDC-103) & attachments  
**NOTE: No: 2:** Is extension in parent necessary for copendency? **DOUBLE CHECK** Item 12 above.



11/07/97

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

**LEE**

FWC of Appln. No. 08/583,491

Group Art Unit: 1818

Filed: November 7, 1997

Examiner: M. Allen

FOR: GDF-1

\* \* \*

November 7, 1997

**REQUEST FOR SUSPENSION OF ACTION**

Honorable Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231

Sir:

In accordance with the provisions of 37 C.F.R. 1.103(a), request by way of petition is hereby made to suspend action on the above-referenced application by the U.S. Patent and Trademark Office for a period of six months, up to and including May 7, 1998, based on the following showing of good and sufficient reasons.

A file wrapper continuing (FWC) application under 37 C.F.R. 1.62 is being filed together with this petition. Therefore, no response by applicant to an Office Action is required.

In the Office Action of May 7, 1997, the Examiner has maintained her rejection of the claims under 35 U.S.C. 112, first paragraph. The Examiner's position appears to be that the specification's disclosure of how the claimed invention is to be used is not credible in the absence of declaration

LEE - FWC of Appln. No. 08/583,491

evidence supporting those uses. Although this position is disputed, such evidence is currently being obtained in the interest of furthering prosecution in this application.

The Examiner has withdrawn the portion of the enablement rejection with respect to making the claimed invention. The Examiner admits that the specification would enable the recombinant production of GDF-1 using conventional techniques and the sequence disclosed by the present application.

In view of time required to produce GDF-1, establish an assay which would support use of GDF-1 as disclosed in the specification, collect data from the assay, and prepare a declaration based on the data, applicant requests suspension of action so that the necessary data may be presented to the Examiner prior to a first Office Action on the merits. Like the recombinant production of GDF-1, assays which would establish the biological activity of GDF-1 are known in the art. Applicant submits that such declaration evidence will allow the Examiner to withdraw the enablement rejection and allow the pending claims.

Thus, it is the intent of the undersigned to place the present application in the best posture for further consideration by the Examiner.

The fee as required by 37 C.F.R. 1.17(i) is enclosed herewith. If this fee is missing or insufficient, the Office is hereby authorized to charge our Deposit Account No. 03-

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3975, Order No. 20263/220232 for the missing or insufficient amount, for which purpose a duplicate copy of this paper is attached.

Prompt consideration of this petition and a favorable response are earnestly requested. The Office is invited to contact the undersigned if further information is needed.

Respectfully submitted,

Cushman Darby & Cushman  
Intellectual Property Group of  
PILLSBURY MADISON & SUTRO, L.L.P.

By

*for*

Paul N. Kokulis  
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